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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/875,208	06/06/2001	Yoichi Okudera	3620-P02590US0	6076

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DANN, DORFMAN, HERRELL & SKILLMAN  
1601 MARKET STREET  
SUITE 2400  
PHILADELPHIA, PA 19103-2307

EXAMINER

SWEARINGEN, JEFFREY R

ART UNIT PAPER NUMBER

2145

DATE MAILED: 07/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/875,208

Applicant(s)

OKUDERA, YOICHI

Examiner

Scott M. Collins

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 March 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-41 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-41 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. Claims 1-41 examined.
2. It is hereby acknowledged that the following papers have been received and placed of record in the file: Amendment and Information Disclosure Statement on 03/31/2005.

### ***Response to Arguments***

3. Applicant's arguments filed 03/31/2005 have been fully considered but they are not persuasive. Applicant gives a detailed synopsis of the Tsuei reference and argues that Tsuei does not disclose the system wherein an e-mail is forwarded based on the identity of the sender of the e-mail. The examiner contends that Tsuei has disclosed registering e.mail address changes and forwarding the e-mails appropriately based on the identity of the sender of the e-mail. The examiner stands on the rejection in view of Tsuei – see column 7, line 66 – column 8, line 8.

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

5. The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

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6. Claims 1-41 rejected under 35 U.S.C. 102(e) as being anticipated by Tsuei.

7. Referring to claims 1, 8-10, 23-26, Tsuei has taught an address inquiry system for informing an inquirer of a new address of a user based on an old address of the user via an Internet (Tsuei figure 3), comprising:

a. a database relationally storing at least the old address, the new address, and an address disclosing condition capable of setting a condition whereby the user decides whether to give permission to disclose the new address (Tsuei figure 3, elements 340, 342, 344, 350, 352, and 354)

b. a means for searching the new address corresponding to the old address and the address disclosing condition from the data base when the inquirer sends an inquiry including the old address (Tsuei column 6, lines 20-29);

c. a means for making the user confirm whether the new address is disclosed when the address disclosing condition in searching includes the set condition (Tsuei figure 3, elements 350, 352, and 354; and column 6, line 66 – column 7, line 8); and

d. a means for informing the inquirer of the new address when the user permits the disclosure of the new address (Tsuei column 7, line 19 – column 8, line 4 includes multiple means for accomplishing this task.).

8. Referring to claims 2, 11-12, 35, Tsuei has taught the address inquiry system wherein the data base includes inquirers who are refused a list of specific inquiries about the new address, the system, further comprising a means for refusing an inquiry from the inquirer included in the list (Tsuei column 6, lines 55-65).

9. Referring to claims 3 and 27-28, Tsuei has taught the address inquiry system wherein the database relationally stores a plurality of old addresses and one new address (Tsuei figure 3, elements 340, 342, 344, 350, 352, and 354).

10. Referring to claims 4, 13, 16-18, 29, 34, Tsuei has taught the address inquiry system wherein the address disclosing condition is allowed to be set on each of the plurality of old addresses in the database (Tsuei figure 3, elements 350, 352, and 354; and column 6, line 66 – column 7, line 8).

11. Referring to claims 5, 20-22, 37-41, Tsuei has taught the address inquiry system wherein the old address and the new address each include an electronic mail address or various other types of addresses (Tsuei figure 3, elements 340, 342, 344, 350, 352, and 354 where the phrase “at least one of” requires only one item from the list.)

12. Referring to claims 6, 9, 19, 36, Tsuei has taught the address inquiry system further comprising a means for informing the inquirer of the new address of a predetermined sort according to the sort of the old address included in the inquiry sent from the inquirer (Tsuei column 7, line 19 – column 8, line 4 includes multiple means for accomplishing this task.).

13. Referring to claims 7, 33, Tsuei has taught the address inquiry system wherein the inquiry sent from the inquirer includes a message text sent from the inquirer to the user, the system, further comprising a means for sending the message text to make the user confirm whether the new address is disclosed according to the selection of the user (Tsuei column 6, lines 45-54).

14. Referring to claims 14-15, 30-32, Tsuei has taught the system wherein the attribute information includes a profile of the inquirer (Tsuei figure 3, elements 350, 352, and 354; and column 6, line 66 – column 7, line 8).

*Conclusion*

15. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

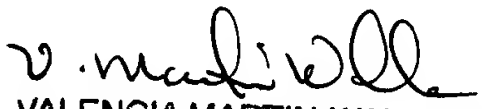
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott M. Collins whose telephone number is 571.272.3934. The examiner can normally be reached on Mon.-Fri. 8:00 am - 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Valencia Martin-Wallace can be reached on 571.272.6159. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

smc  
June 22, 2005

  
VALENCIA MARTIN-WALLACE  
SUPERVISORY PATENT EXAMINER